

REMARKS

Claim 10 is currently amended. Claims 1-9, and 11-26 are canceled without prejudice. Claims 27-38 are new. Claims 10 and 27-38 are pending.

5 Election/Restriction Requirement

The newly canceled claims remained subjected to a restriction requirement under 35 U.S.C. §121 as containing ten patentably distinct inventions. The Office, in deeming its restriction requirement proper, states “Applicant admits that his claims are drawn to at least 4 different inventions.” The Office mischaracterizes the Applicant’s statements. Applicant, in response to the Office’s restriction requirement, stated:

Applicant submits that each of the following four sets of claims may be conveniently searched and examined together without a serious burden to the Office. Each of these sets of claims have been classified and sub-classified identically by the Office. By so classifying these sets of claims, the Office has implicitly established that each set may be searched and examined without a serious burden on the Office.

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For at least this reason, the Office should permit Applicant to select any one of these four sets of claims for examination on the merits.

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The Office is requiring that the Applicant elect from one of 23 groups of claims. If the Applicant desires to have all of the claims of this application examined at once, the Applicant will have to file 22 divisional applications. The cost of this, in PTO fees alone, will be approximately \$22,000. And, on top of these fees, the Applicant will have to pay attorney's fees, administrative costs, and bear many other burdens.

The Office may search and examine the claims of this application with a four-way restriction without undergoing a serious burden and yet is requiring 23. The time, effort, and costs to the Applicant caused by this restriction are extraordinary, placing an unreasonably heavy burden on the Applicant.

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Processing one (or the proposed four) applications instead of 23 applications will certainly require much less time for the Office to properly examine, process, issue, and manage. Many of the burdens that the Office bears in handling an application, especially administrative burdens, will be multiplied by 23. Withdrawing the restriction requirement and keeping the claims together in one application or in four applications as proposed would prove more efficient and effective for the Office in handling the subject invention.

Applicant's traversal argued that the restriction requirement was improper because examining all (or four groups) of the claims will not place the Office under a serious burden under MPEP 803, a requirement to which the Office must follow to restrict the claims. Further, this binding requirement on the Office is independent of whether the claims "include[] claims to distinct or independent inventions". MPEP 803. Thus, even if the claims cover 4, 10, or 26 independent inventions, the Office is still required to examine all of the claims unless it places a serious burden on the Office.

Objection to Drawings

The drawings stand objected to for various informalities. Applicant replaces the drawings, which are attached to a Substitute Drawings Request filed concurrently with this Response. Applicant also amends the specification as noted
5 herein. The amendments to the drawings and specification do not add new subject matter to the application.

Rejections Under 35 U.S.C. §102(e)

Claims 10 and 12 stand rejected under 35 U.S.C. §102(e) as being
10 anticipated by PG-PUB 2003/0140315, filed 7 June 1999, to Blumberg et al. (hereinafter “Blumberg”).

Applicant cancels claim 12 without prejudice.

Argument

15 For the Office’s convenience, Applicant sets forth the language of independent Claim 10.

Claim 10, currently amended, recites a method of providing on-line print services, said method comprising the steps of:

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- receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material;
- electronically distributing said at least one order to at least one print service provider facility;
- 25 • within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device; and
- printing said item according to said order, with said printer device, and on said particular sheet material.

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Applicant respectfully submits that the Office has not shown that Claim 10 recites “receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material”, “electronically allocating said item to a printer device based on said printer device having said
5 particular sheet material loaded on said printer device”, and “printing said item according to said order, with said printer device, and on said particular sheet material”. For at least this reason, Claim 10 is allowable over the art of record.

Conclusion

Applicant respectfully submits that all of the pending claims are in condition for allowance. Accordingly, Applicant requests that the Office issue a Notice of Allowability. If the Office's next anticipated action is anything other
5 than a Notice of Allowability, Applicant requests a phone call to discuss scheduling an interview.

Respectfully Submitted,

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